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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,115	01/22/2004	Roy K. Lim	PC883.00/4906-017	6097
63644 7590 04/29/2010				
MEDTRONIC				
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2600 Sofamor Danck Drive				
MEMPHIS, TN 38132				
EXAMINER				
COMSTOCK, DAVID C				
ART UNIT		PAPER NUMBER		
3733				
MAIL DATE		DELIVERY MODE		
04/29/2010		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/763,115

**Applicant(s)**

LIM, ROY K.

**Examiner**

DAVID COMSTOCK

**Art Unit**

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 November 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-23 and 25-61 is/are pending in the application.
- 4a) Of the above claim(s) 47-61 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,3-23 and 42-45 is/are allowed.
- 6) ☒ Claim(s) 25,27,29,31,32,37,38 and 46 is/are rejected.
- 7) ☒ Claim(s) 26,28,30,33-36,39-41 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-646)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

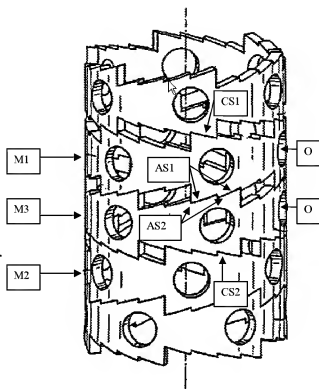
(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 25, 27, 29 and 31 are rejected under 35 U.S.C. 102(a) as being anticipated by Conchy (FR 2,817,463) with reference to the figure below.

Conchy teaches a device to space vertebral members comprising: a first member M1 having an interior side with first and second angled sections AS1 and an exterior side with a first contact surface CS1; a second member M2 having a second interior side and a second exterior contact surface CS2; a third member positioned between the first member and the second member, the third member M3 having a first side with first and second angled sections AS2 positioned towards the angled sections AS1 of the first member M1, and a second side positioned towards the interior surface of the second member M2, the device positionable between a first orientation with the angled sections of the first member disengaged from the angled sections of the third member M3 and having a first height extending between the first contact surface CS1 and the second contact surface CS2, and a second orientation (shown) having the angled sections AS1 of the first member M1 engaged with the angled sections AS2 of the second member M2 and having a second height between the first contact surface

CS1 and the second contact surface CS2, with the second height being greater than the first height.



***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 32, 37, 38 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Conchy (With reference to the aforementioned figure) in view of Brantigan (US 4,787,915).

Conchy teaches a device to space vertebral members comprising: a first member M1 and a second member M2 each having an exterior side CS1/2 and an interior side, the interior sides having ramped surfaces AS1/2 positioned at an angle relative to the exterior sides, the device positionable between a first orientation with the ramped surfaces AS1/2 disengaged and having a first height extending between the exterior surfaces CS1/2, and a second orientation (shown) having the ramped surfaces AS1/2 engaged and having a second height between the exterior surfaces CS1/2, with the second height being greater than the first height.

Hence Conchy teaches all of the limitations of the present invention except a delivery device connected to at least one of the first and second members and having an elongated shape to position the device between the vertebral members; and a deployer operatively connected to one of the first and second members to give movement of the first member relative to the second member.

Brantigan teaches a delivery device 28 having an elongated shape to position a spacing device between vertebral members and a deployer 25. It would have been obvious to one having ordinary skill in the art at the time of the present invention to use the delivery device 28 and deployer 25 to engage the first M1 and second members M2 at openings O. Using the delivery device 28 and deployer 25 of Brantigan would have facilitated implantation of the device taught by Conchy and relative movement of its elements particularly when compared with manipulation directly with the surgeon's hands.

***Allowable Subject Matter***

Claims 1, 3-23 and 42-45 are allowed.

Claims 26, 28, 30, 33-36 and 39-41 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

Applicant's arguments filed 18 November 2009 have been fully considered but are not persuasive. The device of Conchy comprises both an individual and composite tubular shape with opposed ends. The tubular shape can be considered elongated in a direction of a longitudinal axis since it is not flat or plate-like. The longitudinal axis extends through the ends of the member and through the ramps, i.e., through the center of the tubular shape and through the plurality of ramps. The height of the device of Conchy increases in an open orientation (elements rotated with respect to each other to a relatively more spread-apart configuration). Finally, it is noted that as the tool is threaded into an implant, it clearly pivots relative thereto about the rotation axis.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Comstock whose telephone number is (571) 272-4710 (a detailed message should be left if Examiner is unavailable). If attempts to reach the Examiner by telephone or voicemail are unsuccessful, the examiner's supervisor, Eduardo Robert, can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/David Comstock/  
Examiner, Art Unit 3733  
/Eduardo C. Robert/  
Supervisory Patent Examiner, Art Unit 3733